

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Minna MYLLYMAKI, *et al.*

Confirmation No.: 3342

Application No.: 10/812,189

Group Art Unit: 2617

Filed: March 30, 2004

Atty. Docket No.: 089229.00150

For: Controlling Registration in a Communication System

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

September 14, 2010

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program Guidelines, Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 1-63 in the above identified application. Applicants filed a Response to the Final Office Action dated June 14, 2010, and the Office issued an Advisory Action dated September 2, 2010 maintaining the final rejections of claims 1-63. Applicants hereby appeal these rejections and submit this Pre-Appeal Brief Request for Review. As will be discussed below, clear errors exist in the outstanding rejections, which warrant their withdrawal.

The Final Office Action rejected claims 1-11 and 13-63 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Salmivalli, U.S. Patent No. 6,324,399 (“Salmivalli”), in view of Herrero et al., U.S. Publication No. 2005/0009520 (“Herrero”). Applicants submit that there is clear error, due to the fact that the Final Office Action has failed to establish a prima facie case that independent claims 1, 19, 32, 39, and 53, upon which claims 2-11, 13-18, 20-31, 33-38, 40-52, and 54-63 are dependent, are obvious, because the combination of Salmivalli and Herrero fails to disclose or suggest at least one element of independent claims 1, 19, 32, 39, and 53.

Applicants respectfully submit that the present claims recite subject matter which is neither disclosed nor suggested by Salmivalli and Herrero, and that, therefore, the final rejection is clearly improper. Specifically, the combination of Salmivalli and Herrero fails to disclose or suggest, at least, “providing the network entity with control information indicating at least one limitation on a plurality of simultaneous registrations, said control information indicating a restriction on a number of different contact addresses that can be simultaneously registered using

a single public user identity,” as recited in independent claim 1, and similarly recited in independent claims 19, 32, 39, and 53.

Salmivalli does not teach or suggest the aforementioned limitation of independent claim 1 and similar limitations of independent claims 19, 32, 39, and 53. Rather, in Salmivalli, only a limited percentage of the register capacity of the network is allocated to the subscribers of the specific PLMN. See Salmivalli at col. 5, lines 16-21. There is no description or suggestion providing that restriction is based on a number of different contact addresses that can be simultaneously registered using a single public user identity as recited in the independent claims.

Furthermore, Salmivalli describes that registrations may be limited in connection with location updating, when the mobile station has moved to the area of another visitor location register VLR. See Salmivalli at col. 6, lines 7-32; FIG. 5. The subscriber group of the mobile station is identified on the basis of the IMSI (International Mobile Subscriber Identity) sent in connection with the location updating request. See Salmivalli col. 6, lines 12-15. While Salmivalli describes that a home PLMN information of a mobile station is derived from the IMSI, see Salmivalli at col. 5, lines 13-15, Applicants respectfully submit that the PLMN cannot be considered to be analogous to a “single public user identity,” as recited in the independent claims. This is because, a PLMN refers to public land mobile network, and a PLMN identifies a network of a mobile station, rather than a single public user. In addition, Applicants respectfully submit Salmivalli is directed to restricting how many subscribers can be simultaneously registered to the PLMN. In contrast, the independent claims are directed to restricting how many contact addresses a single user can simultaneously register to the network.

The Final Office Action erroneously argues that “[i]t is well known in the art for the NMSI to represent the phone number therefore, the NMSI is the contact address.” See Final Office at page 3, lines 1-2. Applicants respectfully submit that the Final Office Action is incorrect. An IMSI includes a mobile country code (MCC), a mobile network code (MNC), and a mobile subscriber identification number (NMSI). The NMSI does not contain a phone number of the user, and instead includes a unique identifier for a mobile user. In fact, as shown in the Appendix previously filed with Applicants’ Response, a single IMSI, which includes an NMSI, may be associated with multiple phone numbers. See Appendix of Applicant’s Response at page 35, Table 1.2. Therefore, an IMSI, or an NMSI, cannot be considered analogous to “a contact address of the user” as recited in independent claims 1, 19, 32, 39, and 53.

The Final Office Action also alleged that the MCC and NCC of Salmivalli discloses the “single public user identity” recited in independent claim 1, and similarly recited in independent claims 19, 32, 39, and 53. Applicants respectfully submit that this position is incorrect as well. As previously described, an MCC identifies a country, and MNC identifies a network in a country, and neither the MCC, nor the MNC, identify a single public user. Therefore, an MCC, or an MNC, cannot reasonably be considered analogous to a “single public user identity,” as recited in the independent claims.

The Advisory Action alleged that a “contact address,” as recited in the independent claims, does not have to be a phone number, and that a “contact address” is any specific identifier for identifying a particular subscriber. See Advisory Action at page 2. While the Advisory Action is correct that a “contact address” does not have to be a phone number, the Advisory Action is incorrect in alleging that a “contact address” can be any specific identifier for identifying a particular subscriber. Instead, as one of ordinary skill in the art would understand, a “contact address” is an address where a user can be contacted at a given point in time. Specifically, independent claim 1 recites “receiving at least one registration request to register a user requesting a service in a network entity in an internet protocol multimedia core network subsystem of a communication system. The other independent claims recite similar limitations. In the context of an internet protocol multimedia subsystem, the term “contact address” has a specific definition as understood by one of ordinary skill in the art, as evidenced by the Internet Engineering Task Force (IETF) standards document, Request for Comment (RFC) 3261: SIP: Session Initiation Protocol (<http://www.ietf.org/rfc/rfc3261.txt>). Specifically, RFC 3261 states that a “contact contains a SIP or SIPS URI that represents a direct route to contact [a user],” and that a “Contact header field tells other elements where to send future requests.” See RFC 3261 at page 13, emphasis added. RFC 3261 further states that “[r]egistration is one way that the Biloxi.com server can learn the current location of [a user]” and that “the REGISTER message associates [the user’s] SIP or SIPS URI ... with the machine into which he is currently logged (conveyed as a SIP or SIPS URI in the Contact header field).” See RFC 3261 at page 13, emphasis added. As seen in RFC 3261, a contact defines where a user can be contacted at a given point in time. Therefore, one of ordinary skill in the art would not consider a “contact address” as constituting any permanent identity of a subscriber.

The Advisory Action further alleged that, in Salmivalli, “the NMSI is used as the contact address for the network to uniquely identify the subscriber.” The Advisory Action also alleged that “in a group communication involving multiple devices, each NMSI described in Salmivalli would represent a different contact address for representing each subscriber in the group.” See Advisory Action at page 2. Applicants respectfully submit that the Advisory Action is incorrect. Because the NMSI cannot be used to contact the associated subscriber, one of ordinary skill in the art would not consider the NMSI of Salmivalli to be a “contact address” as recited in the independent claims. Furthermore, the Advisory Action’s situation including multiple subscribers is irrelevant, because the independent claims are directed to a situation involving multiple contacts of a single subscriber, as indicated in the limitation “can be simultaneously registered by a single public user identity,” as recited in independent claim 1, and similarly recited in the other independent claims.

The Advisory Action further alleged that “it is well known in the art that the MCC and/or MNC are used as part of the IMSI to uniquely identify a group of subscribers in a network,” and that “the MCC and/or MNC would be the same for each device in the group, i.e., each user in the group, therefore, the MCC and/or MNC is the single public identity.” See Advisory Action at pages 2-3. As previously described, the independent claims are directed to a situation involving multiple contacts of a single subscriber, as opposed to a situation involving multiple subscribers. Furthermore, a MCC and MNC, by definition, refer to a country and network, respectively, and not to a single subscriber. Thus, the Advisory Action is incorrect in its allegation that the MCC and/or MNC of Salmivalli is a “single public user identity” of the independent claims.

Herrero, in turn, does not cure the deficiencies of Salmivalli. Although Herrero describes that each registration of the user contains a public identity assigned to the user and a private identity among the plurality of the private identities assigned to the user, such description, in combination with Salmivalli, does not teach or suggest, at least, “providing the network entity with control information indicating at least one limitation on a plurality of simultaneous registrations, said control information indicating a restriction on a number of different contact addresses that can be simultaneously registered using a single public user identity,” as recited in independent claim 1 and similarly recited in independent claims 19, 32, 39, and 53. Similar to Salmivalli, nothing in Herrero provides a teaching or suggestion that would enable a person of

ordinary skill in the art to provide the network entity with control information using a single public user identity.

In view of the above, Applicants respectfully assert that Salmivalli and Herrero, whether considered does not disclose or suggest all of the limitations of independent claims 1, 19, 32, 39, and 53, and that, therefore, the final rejection is improper and without basis. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the § 103(a) rejection.

The Final Office Action also rejected claim 12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Salmivalli, in view of Herrero, and further in view of Sonti et al., U.S. Patent No. 6,108,540 ("Sonti"). Claim 12 depends upon independent claim 1. As stated above, the combination of Salmivalli and Herrero does not disclose, or suggest, all the elements of independent claim 1. Sonti, also fails to disclose, or suggest, all the elements of independent claim 1, and thus, does not cure the deficiencies in Salmivalli and Herrero. Consequently, there is clear error, because the combination of Salmivalli, Herrero, and Sonti, fails to disclose or suggest all the elements of claim 12. Furthermore, claim 12 should be found allowable for at least its dependence on independent claim 1, and for the specific limitations recited therein.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

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Enclosures: PTO/SB/33 Form, Notice of Appeal